



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/617,165 | 07/08/2003 | Prashant G. Joshi | 1302-49 | 2726 |
| 28249 | 7590 | 09/12/2006 | EXAMINER | |
| DILWORTH & BARRESE, LLP 333 EARLE OVINGTON BLVD. UNIONDALE, NY 11553 | | | POULOS, SANDRA K | |
| | | | ART UNIT | PAPER NUMBER |

1714

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



| | | | |
|---|--------------------------------------|-------------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/617,165 | Applicant(s) JOSHI ET AL. | |
| | Examiner Sandra K. Poulos | Art Unit 1714 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 8/29/06. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-4, 6-9, 14-17, 22-25 and 30-45.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Attachment to Advisory Action

Applicants' amendment filed 8/29/06 has been considered; however, the amendment has not been entered given that it raises other new issues that would require further consideration and/or search.

With respect to other new issues, claims 1 and 42 now recite a newly added limitation of "wherein the total amount of silica is above 100 phr", where it is the examiner's position that this is a new issue since this limitation was not previously set forth in the claims. Applicant has not pointed to any portion of the specification, and examiner has not found support for this phraseology in the specification as originally filed. While there is support for silica being present in an amounts of 80, 90, 95, 100, 105, and 110 phr in the examples, there is not support for the entire range of greater than 100 phr, particularly greater than 110 phr.

Furthermore, Claims 1 and 42 now contain the formula previously presented in Claim 3 and contains the thermoplastics from Claim 36, which results in the dependent claims limited in scope from what they had previously been, necessitating a new search. Claims 25 and 44 are now independent claims rather than being dependent from Claims 1 and 42, respectively, as previously presented. The claims dependent from Claim 25 and 44 are now broader than before due to the lack of the limitation 100 to 160 phr given in Claims 1 and 42 previously. Therefore, the new limitations would require further consideration and/or search. Claims 1 and 42 have been amended to contain an improper Markush group (by inclusion of "or" in the Markush group, which would require a rejection under 35 USC 112, second paragraph.

Claim 36 would be objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claims 39-40 recite that the thermoplastic resin is a high glass transition resin selected from polyamide, etc, which is in conflict with the newly added limitation in Claim 1, that the thermoplastic must be HDPE, LDPE, or ultra high molecular weight polyethylene.

In the interest of better enabling the applicants to assess the patentability of their claims, the following advisory is given:

The issue concerning the new matter rejections/objections set forth previously has not been resolved.

The structure of formula 1 has been amended from $-G-(SiX_3)_3$ to $-G-(SiX_3)_s$ and thereby including $-G-(SiX_3)_2$ and $-G-(SiX_3)_1$ ($s=1$ and 2) which are not supported in the specification as originally filed. Both of applicant's provisional applications, 60/394,264 and 60/60/451,449 also use the $-G-(SiX_3)_3$ formula instead of $-G-(SiX_3)_s$. Applicant's argument that "3" is a typographical error that should have been "s" is not convincing. Applicant points to WO 99/09036 for support, which is not given weight because it is not a priority document or in any way related to the current application except that examiner has used it as prior art. Applicant has pointed to specific blocked mercaptosilanes disclosed in the specification that would meet the formula of $s=2$ and $s=1$. These specific mercaptosilanes would not be new matter if claimed, but the general formula above is new matter because include $s=2$ and $s=1$ present new combinations (by

Art Unit: 1714

varying R, G, Y, and X) that are not previously disclosed. The only way for applicant to overcome the new matter, while still claiming as much as possible, is to change the formula back to $-G-(SiX_3)_3$ and then recite "wherein the blocked mercaptosilane is selected from the group consisting of: blocked mercaptosilanes of Formula (1), blocked mercaptosilanes of Formula (2) [insert formula parameters], and [list of those specifically named blocked mercaptosilanes where $s=2$ and $s=1$ that have support in the specification]".

The argument with respect to the prior art rejections are set forth on the basis of the new limitations introduced via amendment and are not considered by examiner at this time because the amendment has not been entered given that it raises new issues that would require further consideration and/or search.

SKP

Callie E. Shosho
CALLIE E. SHOSHO
PRIMARY EXAMINER